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Ray R. Regan, Registration No. 36,899

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Steve B. Taylor
Sole Inventor: Steve B. Taylor
For: A Coupler
Filing Date: June 20, 2003
Application Number: 10/600,379
Attorney Docket Number: 2236.001
Group Art Unit: 3679
Examiner: Victor MacArthur

APPELLANT'S REPLY TO THE EXAMINER'S ANSWER

To: Mail Stop APPEAL BRIEFS-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

As provided in 37 C.F.R. 1.193 (b) (1), Appellant submits this Reply Brief in response to the Examiner's Answer mailed July 19, 2006, in connection with the above-identified application with the Board of Patent Appeals and Interferences ("Board").

Applicant requests the Board to overrule the Examiner's rejections and to allow the rejected claims in the application.

Appellant filed a Notice of Appeal with the Board on December 16, 2005. In the Notice

of Appeal, Appellant requested reinstatement of the earlier appeal as provided in MPEP §1204.01, and application of fees previously paid by Appellant toward the fees for this appeal, a request Appellant confirms in connection with fees for filing this Brief.

The Commissioner is hereby authorized, however, to charge any fees to Account Number 501565 for the Law Office of Ray R. Regan, P. A., and to deposit any overpayments to Account Number 501565.

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(1) REAL PARTY IN INTEREST

The real party in interest is the Appellant, Steve B. Taylor, an individual, whose mailing address is 4908 Hawkins, N.E., Albuquerque, New Mexico 87109, and whose residence address is 9718 Avenida del Oso, N.E., Albuquerque, New Mexico 87111.

(2) RELATED APPEALS AND INTEFERENCES

No other appeals or interferences will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

(3) STATUS OF CLAIMS

Claims 1-22 are pending in the application.

Claims 23-31 have been cancelled.

Claims 1-22 have been finally rejected and are being appealed.

As stated in Section (9) of this Brief, the appealed claims are set forth in **Appendix A**.

(4) STATUS OF AMENDMENTS

On August 23, 2005 the Examiner reopened prosecution of the application following a first appeal brief filed by Appellant ("Reopened Prosecution") by filing an office action asserting new arguments ("Reopened Office Action") Appellant filed a reply which led to the Examiner filing a final office action ("Reopened Final Action"). Appellant filed no claim amendments subsequent to the Reopened Final Action. Indeed, no claim amendments have been filed in connection with any office action.

Perhaps in an excess of caution, however, if the term "amendment" in 37 CFR §41.37(c)(iv) is deemed to refer to a paper entitled "reply" or "response" to an office action,

rather than an amendment of a claim, Appellant confirms that Appellant did file a Reply to the Reopened Final Rejection, and simultaneously filed the Notice of Appeal to the Board. The Examiner expressly entered the Reply to the Reopened Final Rejection.

(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

A. The apparatus of independent claim 1 is a variably positionable coupler 10 mountable on a curved surface 38'. Coupler 10 is shown by cross-reference between Figures 1-8B. A curved surface 38' is shown in Figures 1 and 3, and described and explained in the specification of the application at page 1, lines 28-29 carried over to page 2, lines 1-26, which also explains why the claimed coupler is needed in the industry. The apparatus of independent claim 1 also includes a base 12 formed with an upper side 14 and a lower side 16, the lower side 16 being is a substantially flat planar surface as shown in Figure 4. The base 12 is shown by cross-reference between Figures 1-3 and 5-9B. The base is described and explained in the specification at page 3, lines 28-29 carried over to page 4, line 1; and at page 6, lines 12-29 carried over to page 7, lines 1-4. The coupler 10 includes means 36 for mounting the base 12 on the curved surface 38'. The mounting means 36 preferably includes one or more ball washer assemblies 40 -- not merely a ball washer -- as explained in the specification at page 4, lines 1-2; page 7, lines 5-25; and shown by cross-reference between Figures 2-4. A tub 70 is provided that is adjustably connectable to the base 12. Tub 70 is shown be cross-reference between Figures 2-3, 5-8B, and shown separately in Figures 10A-C. Tub 70 is described and explained in the specification on page 4, lines 3-6; page 8, lines 4-12 and lines 20-21; page 9, lines 3-6 and 27-29 carried over to page 10, lines 1-8. A plug 72 that is repositionably attachable to the tub 70 is included. The plug 72 is shown be cross-reference between Figures 2-3, 5-8B, and shown separately in Figures 11A-C. Plug 72 is described and explained in the specification on page 4, lines 3-4; page 8, lines 4-24; and page 9, lines 13-16 and 27-29 carried over to page 10, lines 1-8. In addition, a neck 74, rotatably insertable in the plug 72, is provided for securing a shaft 110 shown in Figure 14 to the neck 74. Neck 74 is shown by cross-reference between Figures 2-3, 5-8B, and separately in Figures 12A-C. Neck 74 is described and explained in the specification on

page 4, lines 3-6; page 8, lines 25-29 carried over to page 9, lines 1-6; and on page 10, lines 13-20. A clevis mechanism 96 that is slidably and demountably engageable with the plug 72 and the neck 74 is included. The clevis mechanism 96 is shown by cross-reference between Figures 2, 5-8B, and separately in Figure 13. The clevis mechanism 96 is described and explained in the specification on page 4, lines 5-6; page 6, lines 14-15; page 8, lines 22-24; page 9, lines 4-16; and page 10, lines 1-9.

B. The apparatus of independent claim 11 is a coupler system 10 that includes a base 12 formed with opposing yokes 18a,b. Coupler system 10 is shown by cross-reference between Figures 1-8B. The apparatus includes a base 12. The base 12 is shown by cross-reference between Figures 1-3 and 5-9B. The base is described and explained in the specification at page 3, lines 28-29 carried over to page 4, line 1; and at page 6, lines 12-29 carried over to page 7, lines 1-4. Opposing yokes 18a,b are shown by cross-reference between Figures 1-2, 5-8B, and separately in Figures 9A-9B. Opposing yokes 18a,b are described and explained in the specification on page 6, lines 12-14 and lines 20-25; page 8, lines 11-12; and page 9, lines 27-28. The apparatus of independent claim 11 also includes means 36 formed in the base 12 for mounting the base 12 on a curved surface 38'. The means 36 mounting the base 12 on surface 38' preferably includes one or more ball washer assemblies 40 as explained in the specification at page 4, lines 1-2, and page 7, lines 5-25, and shown by cross-reference between Figures 2-4. The coupler system 10 also includes a plurality of ball washer assemblies 40 combinable with the mounting means 36. Also included is a boom-swivel device 68 detachably fixable to the base 12 for securing a shaft 110 to the coupler system 10. The boom-swivel device is explained and described in the specification on page 6, line 14; page 6, lines 12-13; and page 8, lines 4-12, where the boom-swivel device is defined to include the tub 70 adjustably connectable to base 12, the plug 72 repositionably attachable to tub 70, and neck 74 rotatably insertable in plug 72. The various components of the coupler system are shown by cross-reference between figures 1-13.

(6) GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1-3 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,697,320 to Murray.

B. Claim 4 stands rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,697,320 to Murray in view of U.S. Patent No. 5,704,749 to Landgrebe.

C. Claim 5 stands rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,697,320 to Murray in view of U.S. Patent No. 5,704,749 to Landgrebe as applied to claim 4, and further in view of U.S. Patent No. 1,257,536 issued to Schroeder (“Schroeder Patent”).

D. Claims 6-13 and 16-22 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,697,320 to Murray in view of U.S. Patent No. 1,257,536 issued to Schroeder.

E. Claims 14-15 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,697,320 to Murray in view of U.S. Patent No. 1,257,536 issued to Schroeder, as applied to claim 13, further in view of U.S. Patent No. 5,704,749 to Landgrebe.

F. Claim 11 stands rejected under 35 U.S.C. §112, first paragraph, as not providing enablement for “a plurality of ball washer assemblies combinable with the mounting means.”

(7) ARGUMENTS

A. Claims 1-3 Not Anticipated Under 35 U.S.C. § 102(b) by U.S. Patent No. 5,697,320 to Murray

The Examiner rejected independent claim 1 (and dependent claims 2-3) as anticipated by U.S. Patent No. 5,697,320 issued to Murray on December 16, 1997 (“Murray Patent”), an argument that Appellant respectfully traverses because the Murray Patent does not disclose each and every limitation of the claim as presented. Accordingly, Appellant respectfully urges the Board to overrule the rejection of independent claim 1 and dependent claims 2 and 3.

35 U.S.C. §102 (b), cited by the Examiner as the basis for rejection of Claims 1-3, provides:

“A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States....”

Appellant respectfully submits that the Murray Patent does not anticipate claims 1, 2 or 3 because the Murray Patent does not disclose each and every element claimed by the Appellant. As repeatedly noted by the Appellant, the Murray Patent does not satisfy the “all-elements” rule of MPEP §2131, which provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference...The identical invention must be shown in as complete detail as contained in the claim...[and] the elements must be arranged as required in the claim. (Emphasis added)

Appellant adopts and incorporates by reference all arguments made by Appellant in the original Appeal Brief filed on May 4, 2006.

In addition, claim 1 is allowable for the reason that Murray does not disclose “a plug repositionably attachable to the tub” as recited in the claim and incorporated by reference into claims 2 through 10.

The Examiner argues that the “plug” is found in the Murray patent with reference to the marked-up Figures 4 and 5. (The drawing figures of interest here are shown the Appellant’s Appeal Brief at pages 13 and 14.)

The Examiner states that the plug disclosed in Murray includes the “upper portion of 42 and 71”. See Examiner’s Answer, p. 7. The Examiner does not describe how the “plug” found in the Murray reference is repositionable. For reference, the Examiner refers to the tub as a marked-up number 100. By way of comparison, the Murray specification refers to element 42 as a leg, element 71 as a T-fitting, and element 55, which is structurally similar to the Examiner’s number 100, as an eyelet. See Murray Patent, column 3, lines 51-66, and column 4, lines 1-20 and Figures 4 and 5. These elements do not combine, functionally, structurally or otherwise to disclose a plug repositionably attachable to a tub.

Under any combination of elements disclosed in the Murray Patent, there is none that renders a plug repositionably attachable to the tub. There is no evidence or suggestion in the Murray specification that the leg (42) is repositionably attachable to the tub (100). If anything, one skilled in the art must assume that the leg (42) is fixed in relation to the tub (100) as any twisting or torsional motion on the leg (42) would dislodge it from the tub (100) and/or compromise the structural integrity of the leg (42). At best, the eyelet (55) disclosed by Murray is arguably repositionable with respect to the T-fitting (71), but as the Examiner has conceded throughout this prosecution, the eyelet (55) is not part of the “plug” of the Murray Patent—only elements 42 and 71 are.

Accordingly, assuming for purposes of argument that the Examiner is correct in construing the leg (42) and the T-fitting (71) as a “plug”, there is no suggestion in the Murray Patent that these combined elements are repositionable within any reasonable interpretation of the term. On the contrary, the Murray Patent specifically teaches that the “T-fitting 71 slides onto the tube and is split so that by tightening the bolt 53 the T-fitting squeezes onto the tube and is secured thereto.” See Murray Patent, column 4, lines 12-14, emphasis added. In other

words, the T-fitting (71) is fixed with respect to the leg (42), and thus cannot be repositionable either alone or in combination. As such, the Murray Patent does not disclose a “plug repositionably attachable to the tub” as recited in claim 1, and therefore the standing rejection under section 102(b) should be overruled. In addition, Figure 8 of the Murray Patent shows the canopy in a folded down configuration (as compared to the raised configuration in Figure 1). If one were to rotate the components that the Examiner has identified as being identical to those of Appellant’s coupler, under no conceivable way could the canopy be lowered as shown in Figure 8.

In addition, the Examiner has construed the terms “plug” and “tub” with purely functional language. The Examiner responded that “element 100 of Murray is a tub in that it is hollow and open at one end”; and further that “element 42 of Murray is a plug in that it acts to plug an opening in element 100”. See Examiner’s Answer, p. 15. These arguments are unsupportable. As clearly shown in Figure 5 of the Murray Patent, leg (42) is hollow, and therefore cannot be said to plug anything. Accordingly, the Appellant respectfully reiterates that the Murray Patent does not disclose a plug, even one functionally defined by the Examiner, which is repositionably attachable to a tub, as recited in claim 1.

Accordingly, the Appellant respectfully submits that the Murray Patent does not anticipate claim 1 under 35 U.S.C. §102, and that therefore claim 1 is allowable. Claims 2 and 3, being dependent upon claim 1, are also in condition for allowance as the Murray Patent does not otherwise teach or disclose the limitations incorporated therein through claim 1.

B. Claim 4 Is Not Unpatentable Under 35 U.S.C. § 103(a) over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 5,704,749 to Landgrebe

The Examiner rejected dependent claim 4 under 35 U.S.C. §103(a), claiming obviousness over the Murray Patent in view of U.S. Patent No. 5,704,749 issued January 6, 1998 to Landgrebe (“Landgrebe Patent”).

However, because the Murray Patent does not anticipate independent claim 1, dependent claim 4 is allowable.

In addition, 35 U.S.C. §103(a) provides:

A patent may not be obtained though the invention is not identically disclosed or described as set for in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Appellant respectfully submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

As predicate to overcoming the rejections of the claim, Appellant adopts and incorporates by reference the arguments made in connection with the rejections under 35 U.S.C. §102 above. Moreover, as stated in the MPEP §706.02(j), to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. The cited reference “must expressly or impliedly suggest the claimed invention...” The Examiner points to nothing in either reference that might provide either a suggestion or motivation to modify the Murray apparatus, or to combine the teachings.

The apparatus of the Murray Patent mentions nothing about curved surfaces. The Murray Patents includes no suggestion that the Murray Apparatus is designed for mounting on a curved surface. Indeed, a figure-by-figure review of the drawing figures in the Murray Patent confirms that the apparatus of the Murray Patent is shown mounted only on flat surfaces.

Accordingly, Appellant respectfully urges that claim 4 is not rendered obvious by the combination of the Murray and Landgrebe Patents because the Examiner has failed to provide a *prima facie* case for obviousness, and that the rejection be overruled.

C. **Claim 5 Is Not Unpatentable Under 35 U.S.C. § 103(a) over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 5,704,749 to Landgrebe and further in view of U.S. Patent No. 1,257,536 to Schroeder**

The Examiner rejected Claim 5 as unpatentable under 35 U.S.C. §103(a) over the Murray Patent in view of the Landgrebe Patent, further in view of U.S. Patent No. 1,257,536 issued to Schroeder on February 26, 1918 (“Schroeder Patent”).

As predicate to overcoming the rejection, Appellant adopts and incorporates by reference the arguments of Appellant made in connection with the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 above .

Preliminarily, because the Murray Patent does not anticipate independent claim 1, dependent claim 5 is allowable.

In addition, the Examiner states that the Murray Patent does not disclose the types of washers and fasteners that might be used to mount the Murray apparatus on a surface. The Examiner also concedes that the Schroeder Patent is limited in application to “land vehicles.” According to the Examiner, however, it would have been obvious to use ball washer means to combine the references.

Once again, however, as indicated above, to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. The cited reference “must expressly or impliedly suggest the claimed invention....”

The Examiner points to nothing in either reference that might provide either a suggestion or motivation to modify the Murray apparatus, or to combine the teachings. The limitation of the Schroeder Patent in connection with land vehicles appears to remove that reference from consideration in Appellant’s environment. Although the Examiner argues on page 8 of the Office Action that “it would have been obvious...to adapt the means for mounting, as taught by Schroeder, to be used at each hole of the Murray means for mounting,” once again the Examiner points to no suggestion, no motivation, no teaching recited in either reference to support such an argument.

Accordingly, Appellant respectfully urges that claim 5 is not rendered obvious by the combination of the Murray, Landgrebe and Schroeder Patents as the Examiner has failed to make a *prima facie* case for obviousness, and that the rejection be overruled.

D. Claims 6-13 and 16-22 Are Not Unpatentable over U.S. Patent No. 5,697,320
Murray in View of U.S. Patent No. 1,257,536 to Schroeder

The Examiner rejected Claims 6-13 and 16-22 as unpatentable under 35 U.S.C. §103(a) over the Murray Patent in view of the Schroeder Patent.

Appellant traverses the arguments, and asserts that none of the rejected claims is unpatentable.

To begin with, 35 U.S.C. §103(a) provides:

A patent may not be obtained though the invention is not identically disclosed or described as set for in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Appellant respectfully submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

As predicate to overcoming the rejections, Appellant adopts and incorporates by reference the arguments of Appellant made in connection with the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 above.

Moreover, for emphasis, as stated in the MPEP §706.02(j), to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable

expectation of success; and (3) the cited references must teach or suggest all the claim limitations. The cited reference “must expressly or impliedly suggest the claimed invention....”

As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Also, and rather significant in this instance, Appellant’s disclosure should not be used as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art. *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Indeed, in connection with all §103 arguments advanced by the Examiner, Appellant submits that the attempted combinations urged by the Examiner are individually and collectively impermissible hindsight prohibited by both the Board of Patent Appeals and Interferences (“Board”), and the Court of Appeals for the Federal Circuit (“CAFC”). The case of *Ex parte Wessels and Kaido*, Appeal No. 2004-0462, Application No. 09/915, 861, is an example. While the case is not binding precedent of the Board, the methodology of analysis based on *In re Fritch* is instructive:

[I]t is our opinion that the examiner has used the hindsight benefit of appellant’s own disclosure to pick and choose elements or concepts from the distinctly different systems of the applied references, and then selectively combine the chosen disparate elements or concepts in an attempt to reconstruct appellant’ claimed subject matter. However, as our court of review [CAFC] indicated in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or “template” in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. (Emphasis added.)

Further, although the Examiner asserts that it would be permissible to modify the coupler by incorporating features of the Schroeder Patent, Appellant respectfully submits it is improper to modify the coupler utilizing that reference. See MPEP §2143.01, the heading of which states that “The Proposed Modification Cannot change the Principle of Operation of a Reference.” To combine the references in the manner sought by the Examiner is an application of impermissible

hindsight in the analysis of Appellant's novel coupler, and would require impermissible modification of the principles of operation of Appellant's coupler.

More specifically:

1. **Claims 6-10 Are Not Unpatentable Over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 1,257,536 to Schroeder**

It is evident that the Schroeder Patent is intended to be deployed only in connection with flat surfaces, not curved surfaces. See Schroeder Patent, Figures 1 and 2, and col. 2, ll. 64-80 for an explanation of that inventor's recommended use of the Schroeder device on first "a horizontal body portion," and second, on a "vertical portion." Unlike the variably positionable coupler claimed and disclosed by Appellant, to reverse the Schroeder device from a horizontal to a vertical orientation, bolt 10 must be removed and reinserted "sideways." See Figures 1 and 2.

The Examiner evidently tries to meet the requirement of MPEP §706 by advancing an argument that the Murray Patent includes the kind of suggestion contemplated by MPEP §706 that would support a *prima facie* case of obviousness. The argument by the Examiner appears to be that the Murray Patent "suggests [in] (col. 2, ll. 61-65) adaptation for use on land vehicles but does not detail such adaptation." (Emphasis added.) For the Examiner, that deficiency, apparently, is resolved by the Schroeder Patent because that patent states that "ball washer means for mounting are beneficial for mounting components in a variety of positions found on land vehicles (automobiles)." The Examiner concludes, therefore, that it would have been obvious to "adapt the Murray means for mounting to a land vehicle...by including ball washers to be used at each hole of the Murray means for mounting, as taught by Schroeder...." Using the terms used by the Examiner, this paper will refer to the foregoing argument of the Examiner as the "Land Vehicle Argument."

The problem with the inductive conclusion of the Land Vehicle Argument is, of course, that there is no suggestion in the cited references to modify the Murray apparatus as contemplated by the Examiner. In addition, there is no indication of any reasonable expectation

of success. Finally, none of the references, as has been shown in the discussion under §102 above, teaches or suggests all the claim limitations of the coupler disclosed in the Application.

The Land Vehicle Argument contravenes MPEP §2143.01 which provides that the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (Emphasis added.)

Also, the Land Vehicle Argument seems to be an instance of constructing an argument by using Appellant’s disclosure as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art, contrary to *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Incorporating by reference all of the foregoing statements recited in this paper, Appellant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Accordingly, Appellant respectfully urges that the rejections of claims 6-10 be overruled.

2. **Claim 11 Is Not Unpatentable Over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 1,257,536 to Schroeder**

The Examiner rejected independent claim 11 as unpatentable under 35 U.S.C. §103(a) over the Murray Patent in view of the Schroeder Patent.

In doing so, the Examiner again invoked the arguments advanced in connection with claims 6-13, including the Land Vehicle Argument.

As Appellant has pointed out, there is neither a suggestion nor motivation recited in either reference to combine elements in the novel manner of Appellant’s coupler, nor any teaching of all the claim limitations. Accordingly although the Examiner argues that “it would have been obvious...to adapt the washer assembly, as taught by Schroeder, to be combined with each hole of the Murray means for mounting...,” the Examiner points to no suggestion, motivation, or teaching recited in either reference to support the argument.

The problem with the inductive conclusion of the Land Vehicle Argument is, of course, that there is no suggestion in the cited references to modify the Murray apparatus as contemplated by the Examiner. In addition, there is no indication of any reasonable expectation of success. Finally, none of the references, as has been shown in the discussion under §102 above, teaches or suggests all the claim limitations of the coupler disclosed in the Application.

The Land Vehicle Argument contravenes MPEP §2143.01 which provides that the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (Emphasis added.)

Also, the Land Vehicle Argument seems to be an instance of constructing an argument by using Appellant’s disclosure as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art, contrary to *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

In addition, Schroeder offers no teaching or suggestion that the Schroeder device is mountable on a curved surface. Attempting to combine the elements of the Murray Patent with the elements of the Schroeder Patent would result in an assembly that certainly would not be stationary on a curved surface, and could rotate only in one plane. Contrary to the Examiner’s argument, the Schroeder ball washer assembly is not “beneficial for mounting components in a variety of positions,” but rather only on a horizontal or vertical position. See Schroeder Patent, column 2, lines 64-80.

Figure 1 of the Schroeder Patent shows the use of only one ball washer. Figure 1 also shows only flat surfaces on the components. Movement of those components in relationship to a longitudinal axis through the ball washer and bolt would be restricted to at best an estimate 5-10 degree movement. It is only when one or more ball washers are combined into the ball washer assemblies 40 included in Appellant’s coupler that the coupler can accommodate a curved surface.

Accordingly, Appellant respectfully requests that the Board overrule the rejection of independent claim 11.

3. Claims 12-13 and 16-22 Are Not Unpatentable Over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 1,257,536 to Schroeder

As Appellant has indicated above, it is evident that the Schroeder Patent is intended to be deployed only in connection with flat surfaces, not curved surfaces. See Schroeder Patent, Figures 1 and 2, and col. 2, ll. 64-80 for an explanation of that inventor's recommended use of the Schroeder device on first "a horizontal body portion," and second, on a "vertical portion." Unlike the variably positionable coupler claimed and disclosed by Appellant, to reverse the Schroeder device from a horizontal to a vertical orientation, bolt 10 must be removed and reinserted "sideways." See Figures 1 and 2.

The Examiner evidently tries to meet the requirement of MPEP §706 by advancing an argument that the Murray Patent includes the kind of suggestion contemplated by MPEP §706 that would support a *prima facie* case of obviousness. The argument by the Examiner appears to be that the Murray Patent "suggests [in] (col. 2, ll. 61-65) adaptation for use on land vehicles but does not detail such adaptation." For the Examiner, that deficiency, apparently, is resolved by the Schroeder Patent because it states that "ball washer means for mounting are beneficial for mounting components in a variety of positions found on land vehicles (automobiles)." The Examiner concludes, therefore, that it would have been obvious to "adapt the Murray means for mounting to a land vehicle...by including ball washers to be used at each hole of the Murray means for mounting, as taught by Schroeder...."

The problem with the inductive conclusion of the Land Vehicle Argument is, of course, that there is no suggestion in the cited references to modify the Murray apparatus as contemplated by the Examiner. In addition, there is no indication of any reasonable expectation of success. Finally, none of the references, as has been shown in the discussion under §102 above, teaches or suggests all the claim limitations of the coupler disclosed in the Application.

The Land Vehicle Argument contravenes MPEP §2143.01 which provides that the "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (Emphasis added.)

Also, the Land Vehicle Argument seems to be an instance of constructing an argument by using Appellant's disclosure as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art, contrary to *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Incorporating by reference all of the foregoing statements recited in this paper, Appellant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Accordingly, Appellant respectfully urges that the rejections of claims 6-10 be overruled.

E. Claims 14-15 Are Not Unpatentable under 35 U.S.C. §103(a) Over U.S. Patent No. 5,697,320 to Murray in View of U.S. Patent No. 1,257,536 to Schroeder as Applied to claim 13 in Further View of U.S. Patent No. 5,704,749 to Landgrebe

The Examiner rejected dependent claims 14-15 under 35 U.S.C. §103(a) as obvious over the Murray Patent in view of the Schroeder Patent, in further view of the Landgrebe Patent.

Appellant incorporates all of the foregoing arguments, and states that dependent claims 14-15 are allowable for at least the same reasons that support allowability of the claims discussed above.

Nothing in any of the cited references suggests or teaches the modifications or combinations argued by the Examiner.

F. Claim 11 Improperly Rejected under 35 U.S.C. §112/1

The Examiner rejected claim 11 under 35 U.S.C. §112/1. Appellant respectfully traverses the rejection.

The Examiner stated that “the problem” with claim 11 “is that it requires a plurality of ball washer assemblies that are not the means for mounting (as provided in the Specification) but rather are combinable with the means for mounting.”

Claim 11 recites (emphasis added):

11. A coupler system, comprising:
a base formed with opposing yokes;
means formed in the base for mounting the base on a curved surface;
a plurality of ball washer assemblies combinable with the mounting means; and
a boom-swivel device detachably fixable to the base for securing a shaft to the coupler system.

The capitalization of the word “Specification” by the Examiner in identifying the asserted “problem” with claim 11, and the argument advanced by the Examiner about “new matter” (addressed below), suggest that the Examiner believes that the term “specification” does not include the drawing figures and claims. If so, that is incorrect.

The term “specification” includes the drawing figures, the description, and the claims. *See Landis on Mechanics of Patent Claim Drafting*, Robert C. Faber, PLI, 4th Ed., Glossary, Appendix E. *See also* 37 CFR §1.71 (“The specification must include a written description....”) (emphasis added); 37 CFR §1.74 (“[w]hen there are drawings, there shall be a brief description of the several views...and the detailed description shall refer to the different views....”) (emphasis added); and 37 CFR §1.75 (“[t]he specification must conclude with a claim....”) (emphasis added). Thus, since time virtually immemorial, the “specification” has been known to include the description, drawing figures, and claims.

The Examiner may also view the element in independent claim 1 (“means for mounting the base on the curved surface”) as the same means claimed in independent claim 11 (“means formed in the base for mounting the base on a curved surface”). They are not the same means.

As stated in Appellant’s specification, “[A]s perhaps best shown in Figure 2, base 12 also includes one or more bores 24. As shown in Figure 2, one or more bores 24a-c are formed in

base 12.” (Emphasis added.) Claim 11 is directed to “means formed in the base for mounting the base on a curved surface.” The ball washer assemblies 40 are not “formed in the base.”

The Examiner apparently supports the rejection by asserting: “[T]he means for mounting that consists of a plurality of ball washers is only one preferred embodiment...such that an equivalent means for mounting that is not one or more ball washers can be used.” Appellant agrees. The Examiner goes on, however, to state: “However the specification does not adequately describe any such equivalent means for mounting much less describe how a plurality of ball washers could be combined with such an equivalent means for mounting.”

Appellant is, however, only required to show one embodiment in the application. See 37 CFR §1.71(b), providing that the specification is to include a description “of a specific embodiment.” (Emphasis added.)

Accordingly, Appellant respectfully requests the Board to overrule this rejection.

The foregoing argument of the Examiner is an analogue of a “new matter” objection advanced by the Examiner and traversed by Appellant. The Examiner objected to the amendment filed by Appellant on June 21, 2005 under 35 U.S.C. §132(a), arguing that the amendment introduced “new matter.”

Appellant respectfully traverses the objection.

The Examiner concedes that the specification is in fact “enabling for mounting means including one or more ball washers (sic, “washer”) assemblies,” citing the specification, page 4, lines 1-2 and page 7, lines 8-9. See the Office Action, page 3. Respectively, those portions of the specification provide (with emphasis added):

Means are provided for mounting the base on a curved surface. As will be explained, the mounting means preferably includes one or more ball washer assemblies.

As shown by cross-reference among Figures 1-4, mounting means 36, in a preferred embodiment of the present invention, is a plurality of ball washer assemblies 40.

Claim 11, the claim rejected by the Examiner, recites that what is claimed is (also with emphasis added):

11. A coupler system, comprising:
a base formed with opposing yokes;
means formed in the base for mounting the base on a curved surface;
a plurality of ball washer assemblies combinable with the mounting means; and
a boom-swivel device detachably fixable to the base for securing a shaft to the coupler system.

The Examiner argues that while the specification is enabling for mounting means including one or more ball washer assemblies, the specification “does not reasonably provide enablement for ‘a plurality of ball washer assemblies combinable with the mounting means’ (line 4 of claim 11).”

As Appellant understands the argument, it seems again to imply that the term “specification” does not include the drawing figures and claims. That is incorrect. The term “specification” includes the drawing figures, the description, and the claims as noted above. As such, claim 11 as originally filed is self-supporting, as it is part of the original specification as filed.

The words found in claim 11, and not amended during prosecution, were expressly provided for in the original claims, satisfying the test set forth in *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 55 USPQ2d 1650 (Fed. Cir. 2000) (“The fundamental inquiry [about a ‘new matter’ rejection] is whether the material added by amendment was inherently contained in the original application.”) The words “plurality of ball washer assemblies combinable with the mounting means” are not merely inherently contained in the original application, but expressly contained in the application.

Accordingly, the terms of claim 11, which are part of the specification, and provide for a plurality of ball washer assemblies combinable with the mounting means, may be included in the description of the specification to clarify the resulting patent.

The Examiner argues that: “The added material which is not supported by the original disclosure is...that ‘mounting means 36...is a plurality of bores 24a-d.’” Appellant respectfully disagrees. The specification clearly and expressly supports the amendment, which was tendered

only to clarify the resulting patent. Thus, claim 11, which is part of the specification, provides for a “means formed in the base for mounting the base on a curved surface.” As previously indicated, the ball washer assemblies are not “formed in the base.” What are formed in the base? Bores are formed in the base. As recited in the Application, page 6, line 25, through page 7, line 4:

In addition, as perhaps best shown in Figure 2, base 12 also includes one or more bores 24. As shown in Figure 2, one or more bores 24a-d is formed in base 12. As shown in Figure 4, one or more bores 24 are also formed with a proximal end 26 and a distal end 28. One or more bores 24a-c are shaped for removable engagement of a second threaded bolt 30. Second threaded bolt 30 is perhaps best shown in Figure 4 as seconded threaded bolts 30c-d. As also shown in Figure 2, and by cross-reference among Figures 3-4, a frustoconical recess 32 is formed adjacent proximal end 26 of the one or more bores 24a-c in base 12. In addition, a concave cup 34 is formed adjacent distal end 28a-c of one or more bores 24 in base 12. (Emphasis added.)

No “new matter” has been entered. Accordingly, Appellant requests withdrawal of the objection.

Conclusion

In view of the foregoing, Appellant respectfully requests that the Board of Patent Appeals and Interferences overrule the Reopened Final Rejection of Claims 1-22 over the cited art, and hold that Appellants’ Claims 1-22 are allowable.

Respectfully submitted,

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(8) CLAIMS APPENDIX

Listing of Claims as Last Amended

1. A variably positionable coupler mountable on a curved surface, comprising:
a base formed with an upper side and a lower side,
wherein the lower side is a substantially flat planar surface;
means for mounting the base on the curved surface;
a tub adjustably connectable to the base;
a plug repositionably attachable to the tub;
a neck rotatably insertable in the plug,
wherein the neck is formed for securing a shaft to the neck; and
a clevis mechanism slidably and demountably engageable with the plug and the neck.
2. A variably positionable coupler mountable on a curved surface as recited in claim 1,
further comprising opposing yokes monolithically extending at substantially right angles from
the upper side of the base.
3. A variably positionable coupler mountable on a curved surface as recited in claim 2,
further comprising one or more bores formed in the base with a proximal end and a distal end,
and further wherein the one or more bores are shaped for removable engagement with a bolt.
4. A variably positionable coupler mountable on a curved surface as recited in claim 3,
further comprising a frustoconical recess formed adjacent the proximal end of the one or more
bores.
5. A variably positionable coupler mountable on a curved surface as recited in claim 4,
further comprising a concave cup formed adjacent the distal end of the one or more bores.

6. A variably positionable coupler mountable on a curved surface as recited in claim 1, wherein the mounting means is a plurality of ball washer assemblies.
7. A variably positionable coupler mountable on a curved surface as recited in claim 6, wherein the plurality of ball washer assemblies includes a second threaded bolt formed with a first diameter.
8. A variably positionable coupler mountable on a curved surface as recited in claim 7, wherein the plurality of ball washer assemblies includes a ball washer.
9. A variably positionable coupler mountable on a curved surface as recited in claim 8, wherein the ball washer is formed with a substantially hemispherical exterior surface, an interior surface, and a duct between the substantially hemispherical exterior surface and the interior surface formed with a second diameter larger than the first diameter of second threaded bolt.
10. A variably positionable coupler mountable on a curved surface as recited in claim 9, further comprising a nut assembly.
11. A coupler system, comprising:
 - a base formed with opposing yokes;
 - means formed in the base for mounting the base on a curved surface;
 - a plurality of ball washer assemblies combinable with the mounting means; and
 - a boom-swivel device detachably fixable to the base for securing a shaft to the coupler system.
12. A coupler system as recited in claim 11, wherein the opposing yokes are formed with opposing apertures.

13. A coupler system as recited in claim 11, wherein the mounting means includes a bore formed in the base.
14. A coupler system as recited in claim 13, wherein the mounting means includes a recess formed in one end of the bore.
15. A coupler system as recited in claim 14, wherein the mounting means includes a cup formed in the other end of the bore.
16. A coupler system as recited in claim 11, wherein the plurality of ball washer assemblies includes a bolt formed with a first diameter.
17. A coupler system as recited in claim 16, wherein the plurality of ball washer assemblies includes a ball washer formed with a duct having a second diameter larger than the first diameter of the bolt.
18. A coupler system as recited in claim 11, wherein the plurality of ball washer assemblies includes a nut assembly.
19. A coupler system as recited in claim 11, wherein the boom-swivel device includes at least one tub adjustably connectable to the opposing yokes.
20. A coupler system as recited in claim 11, wherein the boom-swivel device includes a plug repositionably attachable to the tub.
21. A coupler system as recited in claim 11, wherein the boom-swivel device includes a neck for supporting a shaft rotatably insertable in the plug.

22. A coupler system as recited in claim 11, wherein the boom-swivel device includes a clevis mechanism engageable with the plug and the neck.

(9) EVIDENCE APPENDIX

None.

(10) RELATED PROCEEDINGS APPENDIX

None.